

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDEL

Ser. No.: **09/833,956**

Filed: **April 12, 2001**

For: **SYSTEM AND METHOD FOR LIST
SHOPPING OVER A COMPUTER
NETWORK**

Group Art Unit: **3685**

Examiner: **John M. WINTER**

Attorney File No.: **LH 011**

Confirmation No.: **3820**

Examiner's Answer Mailed On: **7/23/2008**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES

This Reply Brief is responsive to the Examiner's answer mailed on July 23, 2008 (the "Examiner's Answer"), and to Office communication mailed on August 25, 2005, in the above-referenced patent application. The Reply Brief is being filed within two months of the mailing date of the Examiner's Answer. Therefore, the Reply Brief is timely. In accordance with MPEP § 1208(I), the Reply Brief includes these identification and introductory pages, status of claims page, grounds of rejection to be reviewed on appeal page, and supplemental argument pages responsive to the Examiner's Answer.

No fees are needed to file this Reply Brief. If the undersigned attorney is mistaken in this regard, authorization is hereby granted to charge all fees necessary to file this Reply Brief to Deposit Account No. 50-3196.

Applicant-Appellant relies on the Appeal Brief for exposition of the grounds for reversal of the rejections, and takes this opportunity to respond to the Examiner's Answer. Applicant-Appellant intends this Reply Brief to supplement the Appeal Brief, rather than to replace it.

I
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-17 have been canceled.

Claims 18-38 are pending in the application.

Claims 18-38 have been rejected.

Applicant appeals from the rejection of claims 18-38.

II

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 18-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gavarini, U.S. Patent Number 7,080,070 ("Gavarini" in this Reply Brief) in view of Wells, U.S. Patent Number 6,711,586 ("Wells").

III
SUPPLEMENTAL ARGUMENT IN RESPONSE TO EXAMINER'S
ANSWER

A. Claims 21, 28, 33, 34, 36, and 38

In the Appeal Brief, we have presented arguments that no *prima facie* case of obviousness has been made for claims 21, 28, 33, 34, 36, and 38, and therefore each of these claims is separately patentable over Gavarini and Wells. The Examiner's Answer has simply ignored our arguments regarding these dependent claims.

B. Independent Claim 18

The Final Office Action acknowledged (page 3) that Gavarini does not explicitly disclose *searching, during the single search, for all of said plurality of different items on a plurality of data sources*. The Examiner's Answer now again acknowledges (page 4) that Gavarini does not disclose the step. For this reason, both the Final Office Action and the rejections in the Examiner's Answer relied on Wells, citing Wells's column 2, lines 6-46 for the disclosure of this step. We have addressed this contention with five distinct argument points on pages 9-15 of the Appeal Brief. In the first of these points, we argued that the items recited in the independent claim 18 have been selectively designated by the user, while Wells's "selections" are not selected by the user. It appears that the Examiner's Answer concedes this point on pages 9-10 where it relies on Gavarini for the disclosure of "the ability to update the quantity field in a list of items [which] meets the limitations of the claimed invention," citing Gavarini, column 2, lines 42-54. Thus, it appears that to meet the certain features of the step of *searching, during the single search, for all of said plurality of different items on a plurality of data sources*, the Examiner's Answer uses both Gavarini and Wells. Neither

reference therefore discloses *searching, during the single search, for all of said plurality of different items on a plurality of data sources*, where the different items or selections have been *selectively designated by the user*.

The ability to allow the user to select items for purchase does not imply or suggest the ability to perform a single search for the selected items, and the Examiner's Answer offers no reason whatsoever a person skilled would have had to come up with the method or apparatus to perform such a search.

The Examiner's Answer did not respond to our argument that Wells does not disclose searching on a plurality of *data sources*, or that motivation to combine is lacking, beyond simply restating the contentions in the Final Office Action.

Most important, the Examiner's Answer did not respond to our argument that Wells does not disclose a single search for all the selected items. As we have argued, Wells describes, *inter alia*, a plurality of iterative searches based on a user's expressed level of interest in an item. *See, e.g.*, Wells, the Abstract. If a search produces a selection of particular interest to the user (called a *terminal selection*), the user can rent or buy the selection, but apparently only one selection at a time can be a terminal selection. Here is how the process is described:

In certain cases, one of the initially provided selections may be of particular interest to the user. Such a selection, i.e., one that satisfies a query of the user, is defined as a terminal selection. In general, the Web page is configured to provide the user with further options once a terminal selection has been found. For example, the Web page includes a selectable rental button 120 and a selectable purchase button 125 configured to allow the user to request information regarding, for example, the sale or rental of an item relating to a terminal selection. As before, when a user clicks on rental button 120 or purchase button 125, a request is received by the server to transmit information to client computer 11 related to this request. Thus, the present invention provides a method for the user to purchase or rent any of the selections such as, for example, the movie HALLOWEEN 110e.

Wells, col. 6, lines 25-40. In this quoted paragraph Wells speaks of one of the initially provided selections, which the user can purchase by clicking on the purchase button 125. Wells does not disclose or suggest a single search for multiple items selected by the user.

IV
CONCLUSION

For the foregoing reasons and the reasons set forth in the Appeal Brief, Applicant-Appellant respectfully submits that all pending claims are patentable and requests reversal of the rejections.

Respectfully submitted,

Dated: September 23, 2008

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